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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/518,060	03/02/2000	Andrew Scott Field	KDO.188020-1	5292
25763	7590	01/09/2006	EXAMINER	
DORSEY & WHITNEY LLP INTELLECTUAL PROPERTY DEPARTMENT 50 SOUTH SIXTH STREET MINNEAPOLIS, MN 55402-1498			POND, ROBERT M	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/518,060	Applicant(s) FIELD ET AL.	
	Examiner Robert M. Pond	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,5,6 and 8-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 5, 6, and 8-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 27 October 2005 has been entered.

Response to Amendment

The Applicant amended claims 2, and 6, and canceled claims 3 and 7. All pending claims (2, 5, 6, and 8-11) were examined in this non-final office action.

Response to Arguments

Pertaining to Rejection under 35 USC 103(a) in previous office action

Applicant's arguments filed 27 October 2005 have been fully considered but they are not persuasive. Greulich and Real-time teach and suggest the claimed invention. Greulich teaches the system receiving from the customer files that contain images (e.g. logo graphics, form layout image data). Real-time specifically discloses online customer configuration, arriving at a real-time quotation, and then placing the order (please see Item U, page 2). A web

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browser that provides an application service, such as real-time quoting, that is delivering the application to the user via the browser interface is embedding code executable by the client computer. In general terms this is software. For sure it is not hardware.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 1. Claims 2, 5, and 8-11 are rejected under 35 USC 103(a) as being unpatentable over Greulich (Paper #20050401, US 5,241,464) in view of Real-time (Paper #20050401, a collection of prior art cited in PTO-892, Items: U-W).**

Greulich teaches the creation and ordering of custom business forms on a customer computer and transmitting ordering parameters, design, and verbiage electronically to an order-receiving computer for the printing of business forms. Greulich teaches automatic price calculation at the customer's computer based on inputting ordering information (see at least abstract; Fig. 1 (15, 17, 18, 12, 27); Fig. 4 (40); col. 1, line 53 through col. 2, line 11). Greulich further teaches:

- Providing a customer a pricing engine; displaying automatically the price quote at the customer: pricing includes one or more printing configuration options selected by the customer; displaying on the customer computer (see at least Fig. 4 (46, 41); col. 6, lines 37-66); pricing system (see at least Fig. 8 (58); col. 8, lines 32-34).
- Customer providing image file: graphical representations; customer logo (see at least col. 5, line 21-28); customer providing image file (see at least Fig. 9ad; col. 9, lines 52-63).
- Color: (see at least Fig. 4 (INK); col. 3, line 19; col.6, line 54).
- Payment: paying by credit card, cash on delivery, or account (see at least col. 9, lines 35-51).
- Proofing: proofing before final production (see at least Fig. 1 (22); Fig. 10b (22, 76); col. 2, lines 12-27; col. 10, line 5); displays printed page layout graphically to customer electronically prior to customer finalizing order (please note examiner's interpretation: customer proofing the order) (see at least Fig. 9ab (W)).
- Automatically calculating a price quote based on the one or more printing configurations options selected by the customer: pricing engine automatically and substantially instantaneously calculated a new price quote (see at least Fig. 8 (58); Fig. 9b (64); col. 5, lines 45-49; col. 8, lines 32-67).

- each time the customer selects or enters data for one or more new configuration options at the customer: (see at least Fig. 9b (64); Fig. 9c (Update Pricing); Fig. 9e (Update Pricing); col. 8, line 63 through col. 9, line 63).
- before forwarding to the processing computer at a printing service provider: customer receives pricing updates to finalize the order before printing service provider (e.g. separate production site) receives the order (see at least Fig. 1 (27, 28); Fig. 9ad; Fig. 10b (27, 28); Fig. 11 (27, 28); col. 6, lines 6-11; col. 9, lines 52 through col. 10, line 60).

Greulich teaches all the above as noted under the 103(a) rejection and teaches a) remote ordering of forms, and b) automatically and substantially instantaneously calculating a new price quote, but does not disclose a real-time web browser. Real-time teaches the explosive movement across multiple industries (e.g. electronic commerce, investment, or insurance) to real-time quoting over the Internet using web browsers (e.g. configure custom systems, arrive at a real-time quotation, and placing the order; real-time pricing quotes on stocks; real-time quotes for insurance) (U: see at least page 2; V: see at least page 1; W: see at least page 2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Greulich to implement web browser-based real-time quoting as taught by Real-time, in order

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to provide faster response to customers conducting online transactions, and thereby increase sales.

- 2. Claim 6 is rejected under 35 USC 103(a) as being unpatentable over Greulich (Paper #20050401, US 5,241,464) and Real-time (Paper #20050401, a collection of prior art cited in PTO-892, Items: U-W), as applied to claim 2, further in view of Official Notice (regarding old and well-known in the arts).**

Greulich teaches all the above as noted under the 103(a) rejection and further teaches color printing by the service provider, but does not disclose full color printing. The Examiner takes the position that full-color printing by a service provider was old and well-known in the arts at time of the invention. For example, brochures or forms that are produced in realistic color use full-color processing. Please see Conclusion for relevant prior art. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Greulich and Real-time to provide full-color printing services as taught by Official Notice, in order to provide more realistic color, and thereby attract customers to the service.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US 6,012,070 (Cheng et al.) 04 January 2000; teaches end-user custom form or brochure design supporting full-color processing.
- US 4,908,301 (Grasso et al.) 13 March 1990; teaches full-color processing and business forms.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 703-605-4253. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'R. M. Pond', written in a cursive style.

Robert M. Pond
Primary Examiner
January 4, 2006